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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/415,540 10/08/99 HAWKINS

P PF-0148-2-DI

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HM12/1223

EXAMINER

SLOBODYANSKY, E

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

12/23/99

Please find below and/or attached an Office communication concerning this application or proceeding:

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/415,540

Applicant(s)
Hawkins et al.

Examiner
Elizabeth Slobodyansky

Group Art Unit
1652



☒ Responsive to communication(s) filed on Dec 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 18-22 is/are pending in the application.

Of the above, claim(s) 1 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 18-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

The amendment filed December 13, 1999, 1999 (Paper No.7) canceling claim 17 and amending claims 1 and 18, and adding claims 19-22 has been entered.

Election/Restriction

Applicant's election with traverse of Group II, claims 17 and 18 in Paper No.7 is acknowledged. The traversal is on the ground(s) that the searches for Groups I and II would be overlapping and that similar search has been conducted in the prior application (page 3, 2nd paragraph). This is not found persuasive because while the searches for Groups I and II are overlapping, they include searches of additional classes/subclasses for each Group and require divergent considerations. For example, the search for Group I would require search of class 424, subclass 94.5 that is not required for Group II.

The requirement is still deemed proper and is therefore made FINAL.

Newly submitted claims 19-22 are directed to an inventions of Group II and are rejoined with claim 18.

Claim 1 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected inventions, the requirement having been traversed in Paper No. 7.

Claims 18-22 are under consideration.

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Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

The first sentence incorrectly indicates that the instant application is a divisional of application 08/741,437.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19, with dependent claims 18-22, is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 20-22 recite at least 16, 30 and 60 contiguous nucleotides of SEQ ID NO:2. Claim 19 recites "a naturally-occurring polynucleotide sequence having at least 90% sequence identity to the sequence of SEQ ID NO:2". The examiner is unable to

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locate adequate support in the specification for such limitations. Furthermore, the specification teaches a probe derived from SEQ ID NO:2 and not from a 90% identical sequence (page 33, lines 22-25). Thus, there is no indication that a naturally-occurring polynucleotide sequence having at least 90% sequence identity to the sequence of SEQ ID NO:2 as well as a probe comprising at least 16, 30 or 60 contiguous nucleotides of SEQ ID NO:2 or of a naturally-occurring polynucleotide sequence having at least 90% sequence identity to the sequence of SEQ ID NO:2 were within the scope of the invention as conceived by Applicants at the time the application was filed.

Accordingly, Applicants are required to cancel the new matter in the response to this Office Action.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Yang et al.

Yang et al. (form PTO-1449, reference 2) teach cDNA encoding bovine pyrophosphatase. This sequence is more than 90% identical to SEQ ID NO:2 and comprises 16, 30 and 60 contiguous nucleotides thereof. Therefore, the sequence of Yang et al. anticipates claim 19. Yang et al. teach the use of the sequence as a probe

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to screen bovine, human and dog libraries (page 24646, left-hand column, and

Fig.8). Therefore, the method of Yang et al. anticipates claims 18 and 20-22.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-22 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 5,843,665 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a DNA encoding SEQ ID NO:1 including the specific DNA of SEQ ID NO:2.

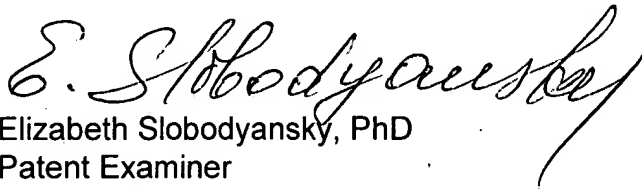
Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.



Elizabeth Slobodyansky, PhD
Patent Examiner

December 15, 1999